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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,116	09/28/2004	Ralph Sutehall	05788.0231	1098
22852	7590	11/28/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			KIANNI, KAVEH C	
			ART UNIT	PAPER NUMBER
			2883	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EL

<b>Office Action Summary</b>	<b>Application No.</b> 10/509,116	<b>Applicant(s)</b> SUTEHALL ET AL.	
	<b>Examiner</b> Kianni C. Kaveh	<b>Art Unit</b> 2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-28 and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, and 28-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



### DETAILED ACTION

Applicant's election with traverse of claims 1-10, and 28-29 in response/amendment submitted on 9/19/05. The traversal is on the ground(s) that search and the examination of the entire application can be made without serious burden. This is not found persuasive because Inventions I and II are product claims, optical fiber unit, that have specific thickness in which they do not have to be dry coated through application of heat and can be coated such as by a tape coating and without applying heat and that in the case of invention III, the application of the coating is independent of the thickness of the sheath. Further, invention group I drawn to an optical fiber unit including sheath having a coating of adherence reducing material particles which is a different invention than that of Group invention II that is drawn to an optical fiber unit for blown fiber installation including a sheath defined by a generally tubular wall having a radially outermost surface and a coating adhered to said radially outermost surface of said wall. Thus, each of the above group inventions directed to an invention that is distinct, and requires a different search, than that of other invention. The requirement is still deemed proper and is therefore made FINAL.

### Specification

Specification is objected since portions of words/sentences are not clear throughout the specification. The applicant is advised to send the original copy of the specification with clear wordings. No new matter should be entered within the words/sentences.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 6-7 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2883

Claims 1-3, 6-7 and 29 recites the limitation 'not substantially greater than' is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The above limitation makes the scope of the invention indefinite. Corrections are required.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-10 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama Norio (JP359188604A) .

Regarding claim 1, 4, 9 and 29 Norio teaches an optical fibre unit (shown in fig. 1) comprising a tubular jacket and a plurality of optical fibre elements loosely housed in

Art Unit: 2883

said tubular jacket (see fig. 1, item 2 representing bundle fibers within the tube and at least see page 9, second column), said tubular jacket having outer surface with a coating of adherence reducing material particles/graphite and a radial thickness not substantially greater than 0.3 mm (see at least page 20, second column, 3<sup>rd</sup> and 4<sup>th</sup>-5<sup>th</sup> parag.).

However, Norio does not explicitly state that the above jacket is a sheath and wherein said tubular jacket has a nominal outside diameter of 1.3 and/or 1.1 mm.

Nevertheless, Norio states that the outside diameter is .4 mm (see at least page 21, 1<sup>st</sup> column, 1<sup>st</sup> parag.). It is obvious/well—known to those of ordinary skill in the art when the invention was made that tubular jacket is/known as sheath and it would have been obvious to a person of ordinary skill in the art when the invention was made to make Noiro's sheath thicker than 0.4 mm as matter of design consideration since such it is extremely conventional to make a larger diameter sheath than 0.4 mm and since such modification would be easier to make high mechanical strength and superior lubricity (see abstract) and since change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Regarding claims 2-3 and 6-8 and 10, Norio further teaches wherein said tubular jacket has a radial thickness substantially not greater than 0.2 mm and/or in the range of 0.05 to 1.5 mm (see at least page 20, second column, 3<sup>rd</sup> and 4<sup>th</sup>-5<sup>th</sup> parag.); wherein said particles have a nominal diameter not substantially greater than 8 microns (see at least page 20, second column, 3<sup>rd</sup> parag.); wherein said particles have a mean nominal diameter not substantially greater than 2 microns (see at least page 20,

Art Unit: 2883

second column, 3<sup>rd</sup> parag.; wherein majority of particles are less than 1 micron in which the average would be much less than 2 microns); wherein said tubular jacket has twelve optical fibre elements loosely housed therein (see at least page 20, second column, 5<sup>th</sup> parag.);

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over combination of Sugiyama Norio and McAlpine et al. (20020197030).

Regarding claim 5, Niro teaches all limitations of claim 1. However, Niro does not specifically teach , wherein said tubular jacket is made of a low smoke zero halogen material. Such limitation is taught by McAlpine et al. whom teaches a fiber unit with all limitations of at least claim 1 (see parag. 0033). Thus, it would have been obvious to a person of ordinary skill in the art when the invention was made to use the material taught by McAlpine since such modification would facilitate making a high mechanical strength and superior lubricity (see abstract).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over combination of Sugiyama Norio and Reeve (EP 0108590A1).

Regarding claim 28, Niro teaches all limitations of claim 1. However, Niro does not specifically teach an installation comprising a conduit and at least one optical fibre unit being installed in said conduit by blowing the optical fibre unit along said conduit. Such limitation is taught by Reeve (see abstract). Thus, it would have been obvious to a person of ordinary skill in the art when the invention was made to use the installation of Reeve to blow Norio's fiber units into Reeve's conduit as shown in figures 1-4 and

Art Unit: 2883

taught in at least abstract, since such modification would facilitate making a high mechanical strength and superior lubricity (see abstract).

### ***Citation of Relevant Prior Art***

Prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In accordance with MPEP 707.05 the following references are pertinent in rejection of this application since they provide substantially the same information disclosure as this patent does. These references are:

McAlpine et al. 6807347 teaches at least claims 1 and 5

Keller et al. 6178278 teaches at least claim 1

Bringuier 2002/0001443 teaches at least claim 1

Polle 5698615

Bringuier 6487347 teaches at least claim 1

Keller et al. 6253012 teaches at least claim 1

These references are cited herein to show the relevance of the apparatus/methods taught within these references as prior art.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Cyrus Kianni whose telephone number is (571) 272-2417.

The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 6:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font, can be reached at (571) 272-2415.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Art Unit: 2883

Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 (for formal communications intended for entry)

**or:**

Hand delivered responses should be brought to Crystal Plaza 4, 2021 South Clark Place, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956.



K. Cyrus Kianni  
Primary Patent Examiner  
Group Art Unit 2883

**KAVEH KIANNI  
PRIMARY EXAMINER**

November 15, 2005

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